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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,968	01/05/2004	Wallace T. Carter		1867

7590 10/31/2006
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EXAMINER SILBERMANN, JOANNE	
ART UNIT 3611	PAPER NUMBER

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/750,968	Applicant(s) CARTER ET AL.	
	Examiner Joanne Silbermann	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-10, 12-21 and 24-60 is/are pending in the application.
- 4a) Of the above claim(s) 29, 32, 33, 39-42, 45-47 and 50-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10, 12-21, 24-28, 30, 31, 34-38, 43, 44, 48, 49, 53-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 29, 32, 33, 39-42, 45-47, 50-52 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.
2. Claim 32 has been held withdrawn, as it pertains to the non-elected hanging embodiment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 30, 31, and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Sachs-Lavery, US PGPub 2004/0128894.
5. Sachs-Lavery discloses a sign comprising a border defined by spaced opposite upper (12A, 12E, 12D) and lower (12B, 12C, 12G) members and spaced opposite side members (12F, 12H) setting off an inboard signage area (for sign 16). The side members are individual tubes (Figure 3) and the upper and lower members have pairs of upward and downward projecting legs (Figure 1) in telescoping relationship with the tubes. The upper and lower members are identical (Figure 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 35 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs-Lavery.

8. Sachs-Lavery does not teach the legs as telescoping internally with the upper and lower member, however this is considered to be a reversal of parts. It would have been obvious to one of ordinary skill in the art to telescope the legs into the side members since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

9. Claims 1-3 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. US #3,371,439 (Smith) in view of Walrath, US #5,134,794 (Walrath).

10. Smith teaches a sign comprising a substantially hollow border (Figure 2) defined by upper, lower and opposite side, substantially hollow members (Figure 1), the hollow border setting off an inboard signage area (Figure 1) and means 120 (Figure 12) substantially filling and rigidifying the border.

11. Smith does not teach hollow, opposed, identical mating bodies defining a hollow chamber when snap fit together, however this is well known in the art. Walrath teaches a sign comprising a hollow border of upper, lower and side members having identical front and back members that snap fit together (Figure 13) to form tubes (Figure 1).

Mating means 21, 22 cooperate to join the front and back members. Edge members 10 provide a channel for retaining a sign in the signage area (Figure 17). The sign also includes pedestal portion 4a.

12. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize a border member, as in Walrath, in the sign of Smith so as to provide a double-sided display.

13. Smith and Walrath do not specifically describe the ends of the side members as being "free" however, based on Applicant's description of the "free" ends, the ends of the side members of the frames shown in the prior art are considered to be free and engaged with the upper and lower members.

14. Smith does not specify a polymeric/copolymeric synthetic thermoplastic material, however such material is well known in the art. It would have been obvious to one of ordinary skill to utilize such material since it has been held to be within the general skill of a worker in the art to utilize such material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

15. Claims 34, 44, 48, 49, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs-Lavery in view of Smith et al.

16. Sachs-Lavery does not teach thermoplastic material in the hollow members, however this is well known in the art as shown by Smith. Smith teaches filling means 120 in the border members. It would have been obvious to one of ordinary skill in the art to utilize such filling means to strengthen the border members of the sign.

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17. Claims 8-10, 20, 21, 24-28, 53 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Walrath as applied to claim 1 above, and further in view of Sachs-Lavery.

18. Smith and Walrath do not teach telescoping side and end members, however this is well known in the art. Sachs-Lavery teaches a sign including side member 12H and 12F which telescopingly engage the upper and lower members (Figures 1 and 3). It would have been obvious to one of ordinary skill in the art to utilize such a telescoping connection in the display of Smith/Walrath so as to provide a sign that may be collapsed for storage or that may be mass produced.

Response to Arguments

19. Applicant's arguments filed 27 January and 12 May 2006 have been fully considered but they are not persuasive.

20. Applicant argues that the prior art does not teach the side members as being tubes having free upper and lower end portions. However, when the sign of Smith is assembled, the side members are hollow tubes. The ends of the tubes of Smith are free but are also engaged with the upper and lower members (as described in Applicant's arguments of 12 May 2006, page 21). The side members shown in Smith are disposed contiguous the upper and lower chambers.

21. Regarding the telescoping members, Applicant argues that Sachs-Lavery teaches away from telescoping side members because it also teaches telescoping upper and lower members. The Sachs-Lavery reference teaches a collapsible sign, the

side members connected by telescoping ends. Such members would enable the sign of Smith to be adjusted.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silberman
Primary Examiner
Art Unit 3611

js
26 October 2006